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EXELIXIS, Inc.
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In re Application of :
Tai et al. :
Application No.: 10/523,706 :
PCT No.: PCT/US03/24561 :
Int. Filing Date: 06 August 2003 : DECISION
Priority Date: 07 August 2002 :
Attorney Docket No.: MBHB05-981-G (EX03-059C-PC) :
For: PSMCs As Modifiers Of The RB :
Pathway And Methods Of Use :

This is a decision on the correspondence filed on 28 November 2005, which is being treated as a request to correct inventorship under 37 CFR 1.497(d).

BACKGROUND

This international application was filed on 06 August 2003 and claimed a priority date of 07 August 2002. The United States was designated. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 07 February 2005. On 04 February 2005, applicants filed *inter alia* the basic national fee.

On 21 March 2005, a signed declaration was filed.

On 28 April 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b).

DISCUSSION

The declaration of the inventors filed on 21 March 2005 lists a joint inventor, Kim Lickteig, who was not nominated in the published international application, nor is an appropriate Form PCT/IB/306 present in the application file. Counsel requests "Correction of Inventorship to add Kim Lickteig as an inventor of the instant application." Though counsel requests treatment under 37 CFR 1.48(a), this request is being treated under 37 CFR 1.497(d). A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have provided an appropriate statement by Kim Lickteig.

Regarding requirement (2), the required processing fee was paid on 28 November 2005.

Regarding requirement (3), the "Consent of Assignee" document included among the instant correspondence is signed on behalf of Exelixis, Inc. By Pamela A. Simonton, who states that she is "Senior Vice President, Patents and Licensing of Exelixis, Inc.," and that she has "the authority to act on behalf of the assignee, Exelixis, Inc., in the specific matter of consent to correct inventorship of the instant application." The "Consent of Assignee" further states that "Exelixis, Inc. consents to the addition of Kim

Lickteig as an inventor of the instant application." Applicants have also provided a copy of an Assignment document executed in favor of Exelixis, Inc. By Albert K. Tai, Chunyan Song, Michael Martin Ollmann, Lucile A. Gillett, Joanne I. Adamkewicz and Kim Lickteig. However, applicants have neither requested that this assignment be recorded nor indicated the reel and frame number where this assignment has been recorded already. Also, insofar as the assignment copy presented appears to have been assembled from individual sheets of one or more separate documents (that is, applicants have not presented complete copies of the document or documents as actually signed), it is not clear whether inventors Adamkewicz and Lickteig signed a complete copy or copies of the document. Therefore, it would not be appropriate to conclude that requirement (3), and the requirements of 37 CFR 3.73(b), have been satisfied, based on the totality of the evidence of record.

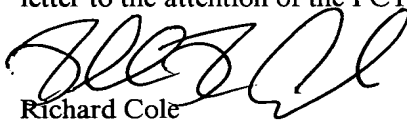
Inspection of the declaration filed on 21 March 2005 reveals that it also appears to have been assembled by aggregating individual sheets signed by each of the inventors into a single document. Since counsel has not provided copies of the complete declaration documents signed by each inventor, it is not clear that each inventor had the benefit of signing a complete copy of the declaration document. Therefore, it would not be appropriate to grant the requested relief at this time.

CONCLUSION

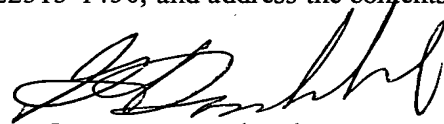
The request under 37 CFR 1.497(d) is DISMISSED, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in ABANDONMENT of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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